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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,962	11/18/2003	Rainer Birkenbach	SCHWP0184USA	5397

7590

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EXAMINER
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KASZTEJNA, MATTHEW JOHN

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 06/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/715,962

Applicant(s)

BIRKENBACH ET AL.

Examiner

Matthew J. Kasztejna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6, 9-12, 15, 16 and 19-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 9-12, 15, 16 and 19-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Notice of Amendment***

In response to the amendment filed on April 29, 2005: amended claims 1-3, 6, 9, 11 (improper claim status identifier), 12 and 15-16; the cancellation of claims 4-5, 7-8, 13-14 and 17-18; and new claims 20-23 are acknowledged. The objection to the drawings has been *withdrawn*. The rejection of claims 2, 4-10 and 17-18 under USC § 112, 2<sup>nd</sup> paragraph, is *withdrawn*. Claims 1-2, 6, 9, and 11-12 and 15-16 stand rejected under 35 USC § 102(b). Claim 3 and 10 stand rejected under 35 USC § 103(a). The following new and reiterated grounds of rejection are set forth:

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 6, 9, 11-12, 15-16, 20-21 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,642,836 to Wang et al.

**In regards to claims 1-2, 20-21 and 23**, Wang et al. disclose a device for coupling at least two medically applicable instruments comprising: a central control unit 12 coupled to input and/or output connections of at least two control apparatuses 14, the central control unit including: at least one processor which (i) receives output signals from the at least two control apparatuses and (ii) converts the output signals into a unified format (see Col. 2, Lines 3-22); and at least one processor 32 which (i) receives

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inputted control signals, (ii) converts the control signals into formats corresponding to the respective at least two control apparatuses, and (iii) transfers the converted control signals to the at least two control apparatuses 14 to control the at least two medically applicable instruments 16; a central input device coupled to the central control unit via a bus (see Col. 2, Lines 34-63); and a central output display device coupled to the central control unit via a bus; wherein the bus provides electrical separation between the central input device and/or the central output display device and the central control unit (see Col. 3, Lines 13-57).

**In regards to claim 6**, Wang et al. disclose a device for coupling at least two medically applicable instruments comprising a central input device 32 coupled to the central control unit and wherein the input device is a voice control interface (see Col. 5, Lines 7-37).

**In regards to claim 9**, Wang et al. disclose a device for coupling at least two medically applicable instruments further comprising a storage unit 44 for storing data captured by the medical instruments and/or data inputted via the data input device (see Col. 5, Line 55 – Col. 6, Line 34 and Fig. 3).

**In regards to claims 11-12 and 15-16**, the operating control system of Wang et al. is considered to be inherently capable of performing the recited method claims (see Col. 3, Lines 6-57).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent No. 6,642,836 to Wang et al. in view of U.S Patent No. 6,117,127 to Helmreich et al.

**In regards to claim 3**, Wang et al. disclose a device for coupling at least two medically applicable instruments, wherein the instruments are coupled to at least two control apparatus but is silent with respect to the at least two control apparatuses coupled to the at least two medical apparatus being provided in a rack. Helmreich et al. teach of an analogous device for providing a medical workstation wherein all of the handheld instruments and components necessary for conducting a surgical procedure are readily available at a single common location (see Fig. 1). It would have been obvious to one skilled in the art at the time the invention was made to include a rack to hold the control apparatuses in the device of Wang et al. in order to provide a more organized operating environment wherein all components are in a concentrated region as taught by Helmreich.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent No. 6,642,836 to Wang et al. in view of U.S Patent No. 6,471,363 to Howell et al.

**In regards to claim 10**, Wang et al. disclose a device for coupling at least two medically applicable instruments, wherein the instruments are coupled to at least two control apparatus but is silent with respect to at least one device forming the system being mounted to a ceiling of an associated operating room. Howell et al. teaches of an

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analogous device for surgical purposes that is attached to the ceiling of an operating theater and comprises various cameras and monitors, which can be pivoted relative to each other, as disclosed by applicants specification. It would have been obvious to mount at least one device in the system of Wang et al. to the ceiling in order to provide optimal viewing in a surgical environment as taught by Howell et al.

Claims 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,642,836 to Wang et al. in view of U.S Patent No. 6,106,512 to Cochran et al.

**In regards to claims 19 and 22**, Wang et al. disclose a device for coupling at least two medically applicable instruments, wherein the instruments are coupled to at least two control apparatus but is silent with respect to wherein the central input device and the single, central output display device are comprised of a single touch screen display. Cochran et al. teach of an analogous system or controlling a plurality of microsurgical instruments having a data communications bus and a user interface 5 connected to the data communication bus for control over the various instrumentation (see Fig. 1 and Col. 6, Lines 28-55). It would have been obvious to one skilled in the art at the time the invention was made to use a flat panel screen as a central input and output device in the system of Wang et al. in order to optimize the performance of the operator and the instruments during surgery as taught by Cochran et al.

### ***Response to Arguments***

Applicant's arguments filed April 29, 2005 have been fully considered but they are not persuasive.

Applicant states that Wang et al. fails to disclose or fairly suggest a central input device and a single, central output display device coupled to a central control unit via a bus, where the bus provides electrical separation between the central input device and/or the single, central output display device and the central control unit. However, Wang et al. discloses that the system may additionally employ a foot pedal, a hand held device or some other device which receives selection or control commands or inputs indicative of such commands from a user (see Col. 2, Lines 33-51). Also, the system may include output means including a video monitor 86 and a speaker 88 (see Col. 3, Lines 49-57). These central input and output devices are considered to be inherently connected via a bus wherein the bus provides electrical separation as Wang et al. teaches of using various busses for transferring information throughout the system (see Col. 7, Lines 43-47).

Furthermore, applicant states that none of the cited references, taken alone or in combination, are understood to disclose or fairly suggest converting received output signal data into a unified format, and transmitting the converted data to a single, central display device coupled to the central control unit, wherein the single, central display device displays data from a medical instrument in one or more windows and/or displays data from different medical instruments in combination. Wang et al. disclose that the control system may include audio and video outputs which are capable of alerting the user to errors in selecting, or controlling specific devices. The audio and video outputs may additionally be used to alert the user to problems with each of the specific devices as well as to provide status notices as to which device(s) are available, which devices

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are active, as well as a host of other device operation information (see Col. 3, Lines 49-57).

Applicant's arguments with respect to claims 19-23 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.




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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJK

6/8/05

  
BEVERLY M. FLANAGAN  
PRIMARY EXAMINER